IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 05-09-2006

CORAM

THE HONOURABLE MR. JUSTICE P.K. MISRA
AND
THE HONOURABLE MR. JUSTICE M. JAICHANDREN

T.M.S.A.NO.1 OF 1999

Dr. Anji Reddy,
5-5-88/2 Fatah Maidan,
Hyderabad –1. .. Appellant/Applicant

Vs.

Hoechst Aktiengesellschaft,
Rep. By Constituted Attorney
Krishnaswami Subramani
Having its Office at
'Hoechst House', Nariman Point,
Backbay Reclamation,
Bombay 400 021. .. Respondent/Opposing Party

Appeal filed under Section 105 of the Trade and Merchandise Marks Act, 1958 against the order of the learned single Judge dated 25.9.1998 in Trade Mark Appeal No.1 of 1996 against the order of the Assistant Registrar of Trade Marks, Madras - 6 dated 01.08.95 and made in Application No.443573.

For Appellant : Mrs. Gladys Daniel for
M/s.C. Daniel & S.P. Karthick
For Respondent : Mr.S. Sampath Kumar,
Senior Advocate for
M/s. Sampath Kumar & Associates

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J U D G M E N T

P.K. MISRA, J

This appeal has been filed under Section 105 of the Trade and Merchandise Marks Act, 1958 against the order of the learned single Judge dated 25.9.1998 in Trade Mark Appeal No.1 of 1996. Such appeal has been filed against the order dated 1.8.1995, passed by the Assistant Registrar

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of Trade Marks directing registration of the present appellant's Application No.443573 in respect of Trademark 'Novigan' in class-5 regarding medicinal and pharmaceutical preparation. Under the said order, the present respondent's objection for registration was rejected.

2. The present respondent is the owner of the registered trademark 'Novalgin' registered under Registration No.148999 in class-5 in respect of pharmaceutical preparation. The present respondent in its objection had opposed the registration on the ground that the trademark applied for by the present appellant was deceptively similar to the trademark registered by the present respondent in respect of the same class of goods. The Assistant Registrar of Trade Marks having rejected such objection, the present respondent had filed appeal before the learned single Judge. The learned single Judge having allowed such appeal, the present second appeal has been filed.

3. The application under the Trade and Merchandise Marks Act, 1958 (hereinafter referred to as "the Act") for registration of the trademark 'Novigan' was filed on 27.9.1985. After preliminary examination, the application was accepted for registration and advertised on 16.7.1988. Thereafter, on 5.10.1988 the present respondent gave a notice with an intention to oppose the said trademark. The main contention in the opposition was to the effect that the trademark has been registered and has been continuously used in India ever since 1956 and the trademark 'Novigan' sought to be registered by the applicant / appellant is deceptively similar to the trademark 'Novalgin' which would lead to confusion and deception and, therefore, such registration was barred under Section 11(a) of the Act.

4. The applicant filed counter statement indicating that in the year 1985 they had honestly and bonafidely adopted the trademark 'Novigan' and, therefore, they were the Proprietors of the trademark 'Novigan' under Section 18(1) of the Act.

5. The Assistant Registrar came to the conclusion that looking at the mark and judging it by sound and look, the rival marks were not identical. The Assistant Registrar further concluded that the rival marks were phonetically and visually different and therefore the registration of the applicant's trademark was not prohibited under Section 12(1) of the Act. While considering the applicability of Section 11(a) of the Act, he came to the conclusion that even though the objector had succeeded in proving the user and reputation of their mark 'Novalgin', but the use of the applicant's mark 'Novigan' would not cause any confusion or deception in the minds of the general public and therefore the objection under Section 11(a) was also liable to be rejected. Ultimately, the Assistant Registrar rejected the objection and allowed the Application No.443573 for registration.

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6. In appeal against such order filed by the objector, the learned single Judge came to the conclusion that distinctive and essential features of both the marks 'Novigan' and 'Novalgin' are two sounds of two letters 'N' and 'G", which are prominent in both those marks and which two words when pronounced, phonetically sound alike. Learned single Judge also observed that two marks are structurally similar and they being two marks in respect of the same class of goods and the drugs used are similar to each other, the order passed by the Assistant Registrar of Trademarks cannot be accepted. Learned single Judge also came to the conclusion that no explanation has been forthcoming from the applicant for adopting such name and it was clearly a deception, not only likely to lead to confusion of the two names, but was obviously intentional.

7. Sections 11, 12(1) and 18 of the Act being relevant, are quoted hereunder :-

"11. Prohibition of registration of certain marks
A mark –
(a) the use of which would be likely to deceive or cause confusion; or
(b) the use of which would be contrary to any law for the time being in force; or
(c) which comprises or contains scandalous or obscene matter; or
(d) which comprises or contain any matter likely to hurt the religious susceptibilities of any class or section f the citizens of India; or
(e) which would otherwise be disentitled to protection in a court,

shall not be registered as a trade mark.

12. Prohibition of registration of identical or deceptively similar trade marks
(1) Save as provided in sub-section (3), no trademark shall be registered in respect of any goods or description of goods which is identical with or deceptively similar to a trade marks which is already registered in the name of different proprietor in respect of the same goods or description of goods.
(2) . . .

18. Application for registration

(1) Any person claiming to be the proprietor of a trademark used or proposed to be used by him, who is desirous of registering it, shall apply in writing to the Registrar in the

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prescribed manner for the registration of his trade mark either in Part A or in Part B of the register.

(2) An application shall not be made in respect of goods comprised in more than one prescribed class of goods.

(3) Every application under sub-section (1) shall be filed in the office of the Trade Marks Registry within whose territorial limits the principal place of business in India of the applicant or in the case of joint applicants the principal place of business in India of the applicant whose name is first mentioned in the application, as having a place of business in India is situate:

Provided that where the applicant or any of the joint applicants does not carry on business in India, the application shall be filed in the office of the Trade Marks Registry within whose territorial limits the place mentioned in the address for service in India as disclosed in the application, is situate.

(4) Subject to the provisions of this Act, the Registrar may refuse the application or may accept it absolutely or subject to such amendments, modifications, conditions or limitations if any, as he may think fit.

(5) In the case of an application for registration for a trade mark (other than a certification trade mark) in Part A of the register, the Registrar may, if the applicant so desires, instead of refusing the application, treat it as an application for registration in Part B of the register and deal with the application accordingly.

(6) In the case of a refusal or conditional acceptance of an application, the Registrar shall record in writing the grounds for such refusal or conditional acceptance and the materials used by him in arriving at his decision."

8. Learned counsel appearing for the appellant has submitted that the learned single Judge has erroneously held that two marks 'Novigan' and 'Novalgin' are phonetically similar.

9. So far as this submission is concerned, we are in complete agreement with the submission made by the appellant. We hardly find any phonetic similarity between the two marks. Except the fact that both the marks start with 'Nov' and most of the letters are similar, when the names are pronounced, we hardly find any similarity. The respondent cannot claim that any other manufacturer cannot use the letters "Nova" or "Nov". As a matter of fact, we have come across many other pharmaceutical

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preparations, which start with the letters "Nova" or "Nov". The two marks are obviously very dissimilar so far as phonetically concerned.

10. It was further submitted by the learned counsel for the appellant that since both the drugs were contained in Schedule 'H', such drugs are expected to be sold only on prescription to be issued by the qualified Doctors and keeping in view the chemical components of the two drugs, there can be hardly any confusion in the minds of the Doctors while prescribing the medicines. It was also submitted by the learned counsel for the appellant that even a purchaser of such medicine, who would not be qualified, is not likely to be confused as the two marks are very dissimilar phonetically and similarly the Druggists and the Chemists sell the drugs are also not likely to be confused in any manner as the salesman is a trained person.

11. Even though the learned Senior Counsel for the respondent combated the aforesaid submission and submitted that two marks are likely to create confusion, we are unable to accept such submission of the learned Senior Counsel for the respondent. It may be true that at times such drugs are sold over the counter even without a prescription, but obviously such a practice if followed is not to be countenanced in law. Moreover, keeping in view the dissimilarity between the two marks in spelling as well as phonetically, we hardly see any scope for upholding the observation made by the learned single Judge that both the marks are deceptively similar.

12. Learned single Judge in his judment has referred to various instances wherein the trademarks were found similar. We have carefully gone through those trademarks as analysed in the decisions and we do not think that the ratio of those decisions can be made applicable to the facts of the present case.

13. It is no doubt true that as observed by the Supreme Court in AIR 1969 SC 449 (AMIRTDHARA PHARMACY v SATYA DEO GUPTA), the question has to be projected from the point of view of a man of average intelligence and imperfect recollection as to whether the overall structural and phonetic similarity between the two names was likely to deceive or to cause confusion.

In our considered opinion, even though the English letters used in the two marks are common, save and except the letter "L", there is hardly any structural and phonetic similarity.

14. In the decision of the Punjab and Haryana High Court reported in AIR 1984 P & H 430 [ANGLO-FRENCH DRUG CO. (EASTERN) LTD. V. M/S. BELCO PHARMA (HARYANA)], two marks 'BEPLEX' and 'BELPLEX' were found to be phonetically similar. But, we hardly see any such obvious

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similarity in the present case between the two marks 'Novigan' and 'Novalgin'.

15. In AIR 1984 Bombay 281 (M/S. HOHANN A. WULFING v. CHEMICAL INDUSTRIAL PHARMACEUTICAL LABORATORIES LTD. AND ANOTHER), 'SEPMAX' and 'SELMAX' were found to be phonetically similar. However, in our considered opinion, that appears to be an extreme case, which cannot be made applicable to the present case.

16. The marks 'GLUCOVITA' and 'GLUVITA' were rightly held to be phonetically and deceptively similar by the Supreme Court in the decision reported in AIR 1960 SC 142 (CORN PRODUCTS REFINING CO., v. SHANGRILA FOOD PRODUCTS LTD.,).

There cannot be any two opinions about the similarity between the marks 'GLUCOVITA' and 'GLUVITA' and therefore we do not think the ratio of the said decision can be made applicable to the present case.

17. On the other hand, in the decision of Madras High Court in AIR 1975 Madras 74 (MOUNT METTUR PHARMACEUTICALS LTD., v. ORTHA PHARMACEUTICALS CORPORATION), the marks 'Utogynol' and 'Orthogynol' were held to be dissimilar and similarly in AIR 1977 Madras 105 (MOUNT METTER PHARMACEUTICALS (P) LTD., v. Dr.A. WANDER), the marks 'ASTHMIX' and 'ASMAC' were held not to be deceptively similar.

18. In 1994 Supp (3) SCC 215 (J.R. KAPOOR v. MICRONIX INDIA), the trademarks 'MICROTEL' and 'MICRONIX' were held to be dissimilar and the fact that the prefix 'micro' was common was considered to be of no significance as such word can be used in respect of the goods MICRO technology.

19. In AIR 1970 SC 2062 (ROCHE & CO. v. G. MANNERS & CO.,) the trademarks 'DROPOVIT' and 'PROTOVIT' were held to be phonetically dissimilar and the common suffix VIT was held to be a common abbreviation for vitamin preparations.

20. In AIR 1988 Madras 347 (INDO-PHARMA PHARMACEUTICALK WORKS LTD. V. CITADEL FINE PHARMACEUTICALS LTD.), the trademarks "ENERJEX" and "ENERJASE" were held to be dissimilar.

21. In 2004(1) CTC 418 (USV LIMITED AND ANOTHER v. SYSTOPIC LABORATORIES LIMITED AND ANOTHER), the marks "PIO" and "PIOZ" were held to be dissimilar since the marks were used to sell the pharmaceutical preparation PIOGLITAZONE.

22. In 2001 PTC 601 (AVIAT CHEMICALS PVT. LTD. & ANOTHER v. INTAS PHARMACEUTICALS LTD.), the Delhi High Court held that the marks "LIPICARD" and "LIPICOR" were phonetically dissimilar and it was observed

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that there several marks on the register of trademarks with the prefix LIPI and the same logic can be made applicable as many marks were with the prefix "NOV".

23. On a careful analysis of all these aspects, we are unable to uphold the conclusion of the learned single Judge.

24. Apart from the above, the law is well settled that when a technically competent body examines the matter, the Court sitting as an appellate authority is not expected to interfere with such order of the technical authority unless the order passed by such technical authority is found to be wholly unsustainable.

25. In the present case, the Assistant Registrar has considered all the relevant facts and circumstances and came to the conclusion that there is hardly any similarity between the two marks 'Novigan' and 'Novalgin' and it is not likely to cause any confusion. In our considered opinion, the order passed by the competent authority under the Act should not have been interfered with in the absence of weighty reasons.

26. For the aforesaid reasons, we are unable to accept the conclusion of the learned single Judge and the appeal is accordingly allowed and the order of the Original Authority, namely, the Assistant Registrar, is therefore restored. There would be no order as to costs.

Sd/
Asst.Registrar

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Sub Asst.Registrar

Dpk

To

1. The Assistant Registrar of Trade Marks, Madras - 6.
2. The Record Keeper, V.R.Section, High Court, Madras.

3 cc To Mr.C.Daniel, Advocate, SR.40852.

JUDGMENT IN TMSA.NO.1/1999

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